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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,155	09/19/2003	Chris C. Zank	PECL-0009	7096

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EXAMINER

JULES, FRANTZ F

ART UNIT PAPER NUMBER

3617

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/666,155

Applicant(s)

ZANK ET AL.

Examiner

Frantz F. Jules

Art Unit

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,9-11,13,14,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,9-11,13,14,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. It is noticed that applicant traversed the rejection of claims 9 and 19 in the response dated 12/15/20005 only on the basis of applicant's arguments regarding unanticipation and non-obviousness of claims 1 and 11 over McCrorey. Since claims 9 and 19 depends from claims 1 and 11, applicant requested that these claims be allowable. Applicant did not traverse the official notice taken of weight body being constructed from steel in the final rejection of claims 9 and 19. Therefore, it is taken or admitted as prior art knowledge in accordance with the MPEP that steel is used in the art of wheel balancing weight.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 10-11 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by McCrorey (US 2,548,842).

McCrorey discloses a wheel-balancing weight for mounting to a wheel with a flange, the weight comprising a weighted body (1) and a clip (6) securely attached thereto, the clip (6) having an attaching section which is the flat section of the clip containing hole 12 and a gripping section constituted by fingers (7, 8) and the body having a gripping portion generally opposite the gripping section of the clip, the gripping section of the clip and the gripping portion of the body in combination defining a compartment

Art Unit: 3617

therebetween, the compartment for receiving the flange therein as disclosed in col 3, lines 16-19 when the weight is mounted thereto such that the gripping section of the clip and the gripping portion of the body are on opposite sides of the flange and grip the flange therebetween, the weighted body (1) having a number of apertures (17) therethrough, the clip (6) having a like number of apertures (12, 13) therethrough, each aperture in the clip corresponding to an aperture in the body, the weight further comprising a like number of attaching members, each attaching member being inserted through a corresponding aperture of the clip and into a corresponding aperture of the body to secure the clip to the body, the attaching member being a stud (14) maintaining a tight interference fit within the corresponding aperture of the body since the stud is held in the in the weighted body by no other external force without coming out. The clip being attached to the body in a fixed manner by each attaching member such that the clip is substantially immovable with respect to the body at each attaching member. The clip being formed as a single piece of material to include both the gripping section and the attaching section as shown in figs. 3-4 and 6.

With regard to the a tight interference fit, it is factual that a tight interference fit is a broad terminology which place no specific degree of tightness in the claim as the word tight is a relative term.

4. Claims 1, 3-4, 10-11, 13-14 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Hume (US 2,036,757).

Hume discloses in figs. 5-6 a wheel-balancing weight for mounting to a wheel with a flange, the weight comprising a weighted body (112) and a clip (12) securely attached

Art Unit: 3617

thereto, the clip (12) having an attaching section which is the flat section of the clip containing stud 13 and a gripping section constituted by overhang 12 and the body having a gripping portion generally opposite the gripping section of the clip, the gripping section of the clip and the gripping portion of the body in combination defining a compartment therebetween, the compartment for receiving the flange therein when the weight is mounted thereto such that the gripping section of the clip and the gripping portion of the body are on opposite sides of the flange and grip the flange therebetween, the weighted body (11) having a number of apertures therethrough, the clip having a like number of apertures therethrough, each aperture in the clip corresponding to an aperture in the body, the weight further comprising a like number of attaching members (13), each attaching member being inserted through a corresponding aperture of the clip and into a corresponding aperture of the body to secure the clip to the body, the attaching member being a stud (13) maintaining a tight interference fit within the corresponding aperture of the body since the stud is held in the in the weighted body by no other external force without coming out. The clip being attached to the body in a fixed manner by each attaching member such that the clip is substantially immovable with respect to the body at each attaching member. The clip being formed as a single piece of material to include both the gripping section and the attaching section as shown in figs. 5-6.

The weight being made of extruded metal and comprising apertures in the body, two apertures in the clip and two attaching members (13) as shown in figs. 5-6 in accordance with claim 3.

Art Unit: 3617

wherein the wheel has an axis and each aperture in the clip, each aperture in the body, and each attaching member is axially aligned to be generally parallel to the axis of the wheel in accordance with claim 4.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hume (US 2,036,757).

Claims 9 and 19

Regarding using a weight body constructed steel as recited in claims 9 and 19, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hume to include the use of a weight body constructed of steel in his advantageous system, as balancing weight material selection is a common and everyday occurrence throughout the balancing weight design art and the specific use of a weight body constructed of steel would have been an obvious matter of design preference depending upon such factors as the amount of unbalance force in the wheel, the yield strength of the balance weight material; the ordinarily skilled artisan choosing the best stress profile corresponding to a particular loading imposed on the wheel which would most optimize the cost and performance of the device for a particular application at hand, based upon the above noted common design criteria.

Response to Arguments

7. Applicant's arguments filed 12/15/2005 have been fully considered but they not persuasive.

A. Summary of Applicant's argument

1. "The McCrorey element 6 which is fixedly attached to the McCrorey body weight 1 cannot be interpreted to be the recited clip of claims 1 and 11 for the reason that such element 6 does not have a gripping section that along with a gripping portion of the body grips the Mccrorey rim c therebetween, as was alluded to above."

B. Response to Argument

1. In response to applicant's argument, it's factual and accurate that McCrorey discloses a clip (6) which meets all of the limitations of the amended independent claims 1 and 11. As explained in the rejection above, clip member 6 comprises two strips or fingers integrally attached to an attaching section (flat section of the steel plate containing hole 12). When clip member 6 is mounted on the weight body 1, these fingers define a space opening or compartment which receives the rim. This is explained in col 3, lines 16-19 of McCrorey. Fig. 3 of the drawing clearly shows the mounting of the these fingers on the rim in plain view. If one draws a straight line joining the tips of these fingers in fig. 3, it is factual that the same straight line intersects the edge of the outer edge of hole opening 20 at point C1. When turning into Fig. 4, its factual that point C1 reveals that fingers 7 and 8 are over flange (c) or the rim of the wheel. Therefore, applicant's argument regarding the failure of clip 6 to provide the

Art Unit: 3617

functions of clipping, clamping or gripping as would a clip do is weak in light of the disclosures of McCrorey.

It should also be pointed out that the attachment of clip member 6 to weight body 1 discloses a weight member and clip combination which is similar to applicant's disclosure as seen in figs. 2B and 2C.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Hoffman et al, Seri, Ende, Wright are cited to show related wheel balancing weight comprising clips attached to the rim.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz F. Jules whose telephone number is (571) 272-6681. The examiner can normally be reached on Monday-Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph S. Morano can be reached on (703) 308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frantz F. Jules
Primary Examiner
Art Unit 3617

FFJ

May 2, 2006

FRANTZ F. JULES
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Frantz', with a stylized flourish at the end.